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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,039	05/24/2001	Victor Nappe	700-210RP	2927

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Anthony R. Barkume Esq  
20 Gateway Lane  
Manorville, NY 11949

EXAMINER

MILEF, ELDA G

ART UNIT PAPER NUMBER

3628

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/865,039	<b>Applicant(s)</b> NAPPE ET AL.	
	<b>Examiner</b> Elda Milef	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/20/2004, 7/23/2001, 9/24/2001</u>                                      | 6) <input type="checkbox"/> Other: ____.                                    |

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## DETAILED ACTION

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-7,9, 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Stimson et al. US Patent No. 5,577,109.

**Re claim 1:** Stimson discloses:

a) the merchant requesting the consumer to provide to it a consumer account identifier that identifies a prepaid consumer account for use with a specific service

b) the consumer providing the requested account identifier to the merchant;

-"the user of an activated card makes a purchase of a particular service or good and provides the card to a representative of the selling party")-see col. 6, line 67- col. 7, lines 1-2;

c) the merchant using a merchant computer to send to a

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digital petty cash server (DPCS) a first transaction request message comprising the consumer account identifier provided by the consumer and a merchant transaction amount for which authorization is being requested ("The seller or user is prompted to enter the 'security code' from the back of the card 50...A purchase amount is also entered indicating the amount of a desired purchase...")-see col. 7, lines 1-25;

d) the DPCS sending an account server a second transaction authorization request message comprising the consumer account identifier provided by the consumer and DPCS transaction amount for which authorization is being requested;

e) the account server determining if the consumer account sufficient to cover the DPCS transaction amount;

-("Entry of the security code enables access to the main processor 54 via a dedicated purchasing network...The host computer 56 of the main processor 54 checks the database for the data associated with the codes.") -see col. 7, lines 6-14.;

f) if the consumer account is sufficient to cover the DPCS transaction amount, then deducting from the consumer

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account the DPCS transaction amount and completing the transaction between the merchant and the consumer ("If a sufficient balance is present, the host computer<sup>56</sup> deducts the entered purchase amount from the card's balance and associates a transaction code with the purchase. The seller then completes the sale to the user.")-see col. 7, lines 18-22;

g) if the consumer account is insufficient to cover the DPCS transaction amount, then denying the transaction between the merchant and the consumer. ("If a sufficient balance is not available, the host computer 56 may issue a receipt or message indicating the available balance and updated information concerning the purchase record.")-see col. 7, lines 13-19.

Also, regarding claim 1, see FIGs. 1 and 4, and col. 3, lines 14-21, col. 4, lines 37-65.

**Re claim 2:** Stimson discloses:

i) the account server sending a first transaction authorization message to the DPCS; -see col. 7, lines 1-25, col. 4, lines 37-65.

ii) the DPCS logging the authorization in a

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transaction database; - see col. 7, lines 18-21.

iii) the DPCS sending a second transaction authorization message to the merchant computer; -see ("The host computer 56 of the main processor 54 checks the database for the data associated with the codes.") -see col. 7, lines 6-14.;

iv) the merchant indicating to the consumer that the transaction has been authorized.-see col. 7, lines 21-25.

**Re claim 3:** Stimson discloses:

i) the account server sending a first transaction denied message to the DPCS ("The host computer 56 of the main processor 54 checks the database for the data associated with the codes and notifies the seller and/or user if a sufficient balance is present...")-see col. 7, lines 13-16, col. 4, lines 37-65;

ii) the DPCS logging the first transaction denied message a transaction database ("The host computer 56 contains sufficient storage associated herewith to enable purchase records to be maintained for each authorized card 50 in the system")-see col. 6, lines 45-51.;

iii) the DPCS sending a second transaction denied message the merchant computer ("The host computer

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56...notifies the seller and/or user if sufficient balance is present...")-see col. 7, lines 14-19. ; and

iv) the merchant indicating the consumer that the transaction has been denied ("If a sufficient balance is not available, the host computer 56 may issue a receipt or message indicating the available balance and updated information concerning the purchase record.")-see col. 7, lines 16-19.

**Re claim 4:** Stimson discloses:

wherein the DPCS capable communicating with a plurality of different account servers, each account server configured to store information on consumer accounts to be used with a different consumer service, and wherein the DPCS determines which of the plurality of account servers should be sent the second transaction authorization request message request by analyzing the consumer account identifier. ("The on-site activation terminals 52 interact with a main processor 54 operated by a host computer 56 via any of a variety of types of interconnecting networks 58, for example, a telephone network. The hardware and software for implementing the main processor 54 and host computer 56 are similar to that discussed with respect to the call

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processor 16 and host computer 12 of FIG. 1. The host computer 56 contains sufficient storage associated therewith to enable purchase records to be maintained for each authorized card 50 in the system. Preferably, each purchase record established in the system includes a number of pieces of information: the card security number, the identity of the store at which the card was issued (i.e., the identification of the authorizing terminal), the card's issue date and time, the card's last use date and time, the card's last recharge number (i.e., the identity of the data terminal at which the card was last recharged), the purchase balance of the card (\$xxx.xx), the card's last recharge amount, the card's last recharge date and time, and transaction codes associated with each purchase. By keeping track of the data terminals at which the card is initially authorized and later recharged, the system operator can reconcile multiple data from different locations. This enables the system operator to credit or charge store operators for recharging providing by other store operators in the system.")-see col. 6, lines 41-65 and col. 7, lines 26-32.

**Re claim 5:** Stimson disclose:



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wherein the account server configured to provide prepaid telephone card calling services in which the prepaid consumer account is used to pay for telephone calls made by the consumer. ("In a preferred embodiment, a pre-paid calling card system enables customers to access a telephone network and obtain long distance telephone service. The system includes four main functional components: a plurality of calling cards, a host computer, a plurality of activation terminals and a call processor.")-see col. 2, lines 31-49.

**Re claim 6:** Stimson disclose:

wherein the consumer prepays for said account by purchasing a telephone calling card, the telephone calling card having imprinted thereon the consumer account identifier. ("The pre-paid cards 50 include a body position 18 and read only memory stripe 20 having a security number stored thereon as shown in FIG. 2; alternatively, the security number may be the user's account number, a personal identification number (PIN) or some other information generally known only to the user whether encoded on the card 50 or not.")-see col. 6, lines 28-34, and col. 3, lines 61-67, col. 4, lines 1-4, and col. 5.

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**Re claim 7:** Stimson disclose:

wherein the consumer account identifier is a telephone number of the telephone card calling service. ("The pre-paid cards 50 include a body position 18 and read only memory stripe 20 having a security number stored thereon as shown in FIG. 2; alternatively, the security number may be the user's account number, a personal identification number (PIN) or some other information generally known only to the user whether encoded on the card 50 or not.")-see col. 6, lines 28-34, see cols.5-6.

**Re claim 9:** Stimson disclose:

wherein the merchant and the consumer each utilize a telephone to communicate with each other over a telephone network in order for the merchant to request the consumer to provide the consumer account identifier and indicate to the consumer that the transaction has been authorized or denied. ("In a preferred call scenario, the possessor of an activated calling card first accesses the service through a dedicated telephone number (such as an 800 number) to which the host computer/call processor are connected...the user is prompted to enter "security code"...the host computer checks the database and gives the appropriate response...")-see col. 5, lines 43-67.

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**Re claim 10:** Stimson discloses:

- a) a merchant computer;
- b) a consumer computer;
- c) a DPCS;
- d) an account server;

-see Fig. 4 and cols. 2-5.

Further regarding the remaining limitations in claim 10, a networked system for executing payment for a transaction would have been necessary to perform previously rejected claim 1 and is therefore rejected using the same art and rationale.

**Re claims 11-16:** Further a networked system for executing payment for a transaction would have been necessary to perform previously rejected claims 2-7 and are therefore rejected using the same art and rationale.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson in view of Nhaissi (PG. Pub. No. US 2005/0203835).

**Re claim 8:** Stimson does not specifically disclose: wherein the consumer utilizes a consumer computer that communicates with the merchant computer over the Internet, and wherein the merchant computer is used by the merchant request the consumer provide the consumer account identifier by sending an account entry form to the consumer computer, and to indicate to the consumer that the transaction has been authorized or denied by sending a web page to the consumer computer. Nhaissi however, teaches

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connecting to the Internet using any computer, see para. 15, purchasing a physical item or service on the Internet - see para. 82, the user providing a number and password to the Internet site to verify use of prepaid account-see para. 9, and sending authorization to the user permitting the transaction as a result of available account balance-see pp.3-7. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stimson to include a consumer using a computer to communicate with a merchant computer in order to purchase a good or service and the consumer receiving notification that a transaction is authorized based on the balance in a prepaid account as was taught by Nhaissi in order to allow the user the freedom to order an item using any computer with access to the Internet.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,507,644 (Henderson et al.)-cited for a pre-paid telephone calling card linked to a stored value account.

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US Patent No. 6,473,500 (Risafi et al.)- cited for a system and method for using a prepaid card.

US Patent No. 6,185,545 (Resnick et al.)-cited for electronic payment system utilizing intermediary account.

PG Pub. No. US 2004/0195316 (Graves et al.)-cited for a system and method for managing stored-value card data.

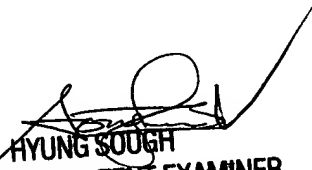
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday - Friday 9:15 am to 5:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600